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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,647	09/19/2003	Nareak Douk	P1585 US	6082

7590 05/03/2006
Catherine C. Maresh
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EXAMINER

GRAY, PHILLIP A

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/665,647	Applicant(s) DOUK ET AL.	
	Examiner Phillip Gray	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3,9-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,9-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicants amended claims of 2/13/2006. Currently claims 1-3,9-12,14 are pending and rejected.

Response to Arguments

Applicant's arguments filed on 2/13/2006 have been fully considered but they are not persuasive. Applicant argues that the rejection by Moorhead fails to teach all the elements of claims 1 as currently amended. Applicant argues that the valves, struts, and apertures, must be outside the patient and Moorhead doesn't disclose this. Further, Applicant argues that Moorhead reference fails to particularly point out all teachings to the limitations of claims 2-3 and 9-12.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applicant argues that the valves, struts, and apertures, must be outside the patient) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Concerning the fact that applicant argues that the valves, struts, and apertures, must be outside the patient, the claim language doesn't not specify this limitation. The claim language states that "...the proximal portion extending out of the patient during use..." and "...the struts and apertures interspaced around the circumference of the proximal portion of the

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catherter...". Moorhead does indeed disclose a catheter that teaches and satisfies the language of claim 1. The requirement that the valves, struts, and apertures must be outside of the patient during operation of the catheter are not included in the claim language. Further any portion not distal can be regarded as proximal, and the proximal and distal portion have not been clearly defined in the specification and /or claims. Moorehead is fully capable of having a proximal portion of the catheter extending out of the patient during use. (Figures 1,3,3a)

In regards to applicants argument that Moorhead reference fails to particularly point out all teachings to the limitations of claims 2-3 and 9-12, applicant merely states that Moorhead discloses an invention "other than that claimed by Applicant" (as of claim 3) and lumen would not function if sealed. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. There is no direct or specific argument how Moorhead does not disclose or teach claimed subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,9,12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Moorhead (U.S. Patent Number 5,147,332). Moorhead discloses a catheter having a central lumen, the catheter including a plurality of longitudinal struts (portion of catheter in between the apertures) and longitudinal apertures (66 and 70), the struts and apertures interspaced around the circumference of a proximal portion of the catheter that extends out of the patient during use (figure 14), and a self-sealing polymer (62) disposed on at least a portion of each strut, the polymer separably sealing the struts one to another (Figure 14), wherein the struts separate to allow passage of a fluid into or out of the central lumen, and wherein the struts reseal to prevent passage of a fluid into or out of the central lumen; as to claims 2-3,9,12, and 14 (Narrowly eye-shaped is a relative term).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorhead, in view of Martin et al. (U.S. Patent Number 6,206,849). Martin discloses an adaptor element (38) that may be removably mounted on the proximal portion of the catheter, the adaptor being movable between a first position (closed element) in which a mechanical force is applied to the catheter and a second position (open element) in which the mechanical force is withdrawn, the adaptor being in fluid communication with a fluid delivery device, the adaptor having a first seal (outer steps of 38) to engage the circumference of the catheter, the adaptor having a second seal (inner step of 28) to engage the circumference of the catheter where engaging the first and second seal establishes a fluid tight chamber surrounding the proximal portion of the catheter. (See element 38 closure clamp and figures 1 and 2).

Moorhead discloses the claimed invention except for the adaptor that may be removably mounted on the proximal portion. Martin teaches that it is known to use the adaptor that may be removably mounted on the proximal portion, as set forth in paragraphs at column 4 through 5, to provide a selectable fluid tight seal on a catheter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the catheter as taught by Moorhead with the adaptor that may be removably mounted on the proximal portion as taught by Martin, since such a

modification would provide the catheter with the adaptor that may be removably mounted on the proximal portion for providing a selectable fluid tight seal on a catheter.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAG

KEVIN SIRMONS
PRIMARY EXAMINER

